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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,853	07/22/2003	Tetsuya Okumura	59626 (70904)	8010

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EXAMINER

DILDINE JR, R STEPHEN

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/625,853

Applicant(s)

OKUMURA ET AL.

Examiner

R. Stephen Dildine

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 18-34 and 37-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15, 18-34 and 37-40 is/are allowed.
- 6) ☒ Claim(s) 41-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

I. Claim Rejections - 35 USC § 112

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 41-44 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode is based upon the lack in the disclosure of any listing of a set of instructions necessary to implement the claimed “waveform equalization program for execution on a computer”.
3. Claims 41-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claims 41 through 44 recite a “waveform equalization program for execution on a computer”, however, there is no disclosure in the application of any detail of how such a program might be implemented. The only descriptions of the claimed computer program in the specification are “The present invention relates to a waveform equalizing device, method, and program for adaptive equalization of the waveform of a reproduced signal in a signal reproduction system; a computer-readable storage medium with the waveform equalization program stored thereon; and an information reproducing device and communications device incorporating the waveform equalizing device” (page 1), “a signal quality evaluation program and a computer-readable storage medium having the same” (page 2), “may be constructed of a computer including a CPU (central processing unit) executing instructions in a waveform equalization program implementing the functions of the device” (pages 60-61), “the present invention is achievable by loading into a computer a computer-readable storage medium storing program codes (an execution program, intermediate code program, or source program) of a waveform equalization program which is a software implementation of the aforementioned functions” (page 61), “The waveform equalization program of the present invention is a waveform equalization program of operating any one of the waveform equalizing devices, and causes a computer to function as each of the means” (page 79), “the waveform equalization program of the present invention stores a program causing a computer to function as each of the means” (page 80), “a CPU (central processing unit)

Art Unit: 2133

for carrying out commands of a signal quality evaluation program which realizes functions of the signal quality evaluation section 110” (pages 103-104), “Further, the signal quality evaluation program of the present invention is arranged so that the program causes a computer to function as each of the means” (page 110) and “Further, the computer-readable storage medium storing the signal quality evaluation program of the present invention is a computer-readable storage medium storing the signal quality evaluation program which causes a computer to realizes each of the means so as to operate the signal quality evaluation device” (pages 110-111). These recitations of the disclosure are mere statements of applicants’ intent to carry out the invention by means of a computer program, but they do not provide a written description of said computer program or the instructions necessary to carry it out, therefore, there is no written description of the computer program of claims 41-44.

4. Claims 41-44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The disclosure lacks any listing of a set of instructions necessary to implement the claimed “waveform equalization program for execution on a computer”, therefore, one of ordinary skill in the art at the time of applicants’ invention would be unable to practice the invention of claims 41-44 without inventing a set of computer instructions to carry out the claimed combination.

II. Claim Rejections - 35 USC § 101

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 41 and 43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 41 and 43 recite a computer program *per se*. Data structures not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, *e.g.*, Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure *per se* held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects

Art Unit: 2133

of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

III. Allowable Subject Matter

1. Claims 1-15, 18-34, 37-40 are allowed.

IV. Conclusion

3. Applicant's amendment necessitated the new grounds of rejection presented in this Office action.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

4. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

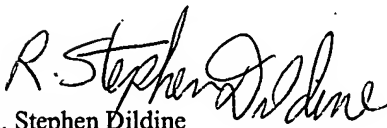
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Stephen Dildine whose telephone number is (571) 272-3820. The examiner can normally be reached on M - F 5:30 am to 2:00 pm.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

7. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Art Unit: 2133

Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


R. Stephen Dildine

R. Stephen Dildine
Primary Examiner
Art Unit 2133